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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/705,481

11/10/2003

Sonya S. Johnson

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EXAMINER

ROBERTS, LEZAH

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

02/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/705,481	Applicant(s) JOHNSON ET AL.	
	Examiner Lezah W. Roberts	Art Unit 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,7-11,14,18-21 and 24-33 is/are pending in the application.
4a) Of the above claim(s) 21 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,4,7-11,14,18-20 and 27-33 is/are rejected.
- 7) ☒ Claim(s) 9, 19 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the Request for Continued Examination filed October 31, 2007. All previous rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims

Claim Rejections - 35 USC § 112 – New Matter (New Rejection)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4, 7, 8, 11, 14, 18, 19, 27-29, 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation "approximately", which does not appear to be originally disclosed by the instant specification and therefore constitutes "New Matter".

Claim Rejections - 35 USC § 112 – Indefiniteness (New Rejections)

Claims 1, 4, 7-9, 11, 14, 18, 19, 27-30, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claims 1, 4, 7, 8, 11, 14, 18, 27-29, 32 and 33 recite the limitation "approximately about". "Approximately" is synonymous with "about" and therefore the recitation of "approximately" is redundant and makes the term "about", which in this case, is otherwise definite indefinite.

2) Claims 9, 19 and 30 recite the limitation "15%" in the second line. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103 – Obviousness (Previous Rejection)

Claims 1, 4, 6-9, 11, 14-16, 18-19, 27-30 and 32-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kumamoto et al. (US 2002/0119231) in view of Sturtz (US Plant 8,645). The rejection is maintained in regards 1, 4, 7-9, 11, 14, 18-19, 27-30 and 32-33 and further applied to claims 10, 20 and 31.

Applicant's Arguments

Applicant argues Kumamoto is entirely directed to warming compositions. The references must be considered as a whole and those portions teachings against or away from the claimed invention must be considered. Kumamoto repeatedly emphasizes that the invention is directed toward providing warming compositions that

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exhibit long-lasting warming effects. In contrast, however, Sturtz is directed primarily toward a new and distinct variety of a mint plant, now known Erospicata. Erospicata can be used as a replacement to various cooling agents, including peppermint, to create a cooling composition without epithelial irritation caused by large amounts of menthol. The warming compositions of Kumamoto teach away from a combination with the cooling compositions of Sturtz, and the skilled artisan would have no reason to combine the cited reference to arrive at the present claims. Applicant submits that unless those portions of the art that teach away from the combination that is proposed are considered, Applicant respectfully submit that almost every invention would be obvious. The Office has improperly applied hindsight reasoning by attempting to selectively piece together teachings of each of the reference in an attempt to recreate what the claimed invention discloses. The combination of reference does not recite all the limitations in the instant claims. Kumamoto also teaches cooling agents that include menthol, which contradicts the teachings of the instant claims. Applicant further asserts not only do the claims require cooling agents that are "non-menthol" cooling agents, but Erospicata is used as a replacement for the menthol commonly used in products like that of Kumamoto.

Examiner's Response

Although Kumamoto discloses warming compositions, it is specifically disclosed that flavors and cooling agents are used in combination with warming compositions. These include peppermint as a flavoring. A cooling agent is specifically disclosed as component (A) and the compositions comprise (A) a cooling agent, (B) a compound

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formula I and (C) a warming agent (paragraph 0011). The cooling agents not only include menthol but also include peppermint as well as isoplegol, menthone and spearmint oil. The preferred cooling agents do not include menthol. Applicant implies that menthol is preferred and must be included in the composition which is not the case. Therefore Kumamoto does not teach away from using cooling agents in the compositions. In regards to Sturtz, it does not disclose that erospicata may only be used in cooling agents. It does disclose that erospicata may replace peppermint oil to reduce irritates nasal, oral and gastrointestinal epithelium. This is motivation why one would replace peppermint or even menthol with erospicata when the taste of peppermint is preferred. The flavor in the chewing gum compositions comprise about 0.8% of the compositions encompassing the instant claims. Applicant appears to be arguing that the Examiner has used improper hindsight reasoning in construing her rejection. The Examiner does not agree, however, since the knowledge used (such as erospicata oil has the taste characteristics of peppermint without the irritation caused by menthol in peppermint) comes from the prior art, not from applicant's specification. Reconstruction of this type is in fact permitted; see *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). One of ordinary skill in the art would have been motivated have substituted peppermint oil with erospicata when a stronger peppermint taste or no menthol was desired.

In regards to claims 10, 20 and 31, normally, changes in result effective variables are not patentable where the difference involved is one of degree, not of kind; experimentation to find workable conditions generally involves the application of no

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more than routine skill in the art. In re Aller 105 USPQ 233, 235 (CCPA 1955). It would have been obvious to adjust the amount of erospicata oil in the flavor composition motivated by the desire to achieve optimum flavor in the oral composition as supported cited precedent.

Claims 1, 4, 7-11, 14, 18-20 and 27-33 are rejected.

Claims 9, 19 and 30 are objected.

Claims 21 and 24-26 are withdrawn.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

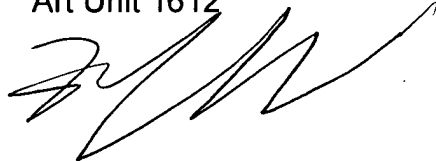
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lezah Roberts
Patent Examiner
Art Unit 1612

A handwritten signature in black ink, appearing to read "Leah Roberts", with a long horizontal flourish extending to the right.

Frederick Krass
Supervisory Patent Examiner
Art Unit 1612

A handwritten signature in black ink, appearing to be a stylized "FK" or similar, with a long horizontal flourish extending to the right.